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PATENT APPLICATION

ATTORNEY DOCKET NO. 10010789-1

IN THE
UNITED STATES PATENT AND TRADEMARK OFFICE

Inventor(s): Patricia S. Kruse

Confirmation No.: 9651

Application No.: 09/929,430

Examiner: M. Milia

Filing Date: August 13, 2001

Group Art Unit: 2622

Title: PRESENTATION PRINT JOB PROFILING

Mail Stop Appeal Brief-Patents
Commissioner For Patents
PO Box 1450
Alexandria, VA 22313-1450

TRANSMITTAL OF APPEAL BRIEF

Transmitted herewith is the Appeal Brief in this application with respect to the Notice of Appeal filed on Jan. 20, 2006.

The fee for filing this Appeal Brief is (37 CFR 1.17(c)) \$500.00.

(complete (a) or (b) as applicable)

The proceedings herein are for a patent application and the provisions of 37 CFR 1.136(a) apply.

☐ (a) Applicant petitions for an extension of time under 37 CFR 1.136 (fees: 37 CFR 1.17(a)-(d)) for the total number of months checked below:

☐ 1st Month
\$120

☐ 2nd Month
\$450

☐ 3rd Month
\$1020

☐ 4th Month
\$1590

☐ The extension fee has already been filed in this application.

☒ (b) Applicant believes that no extension of time is required. However, this conditional petition is being made to provide for the possibility that applicant has inadvertently overlooked the need for a petition and fee for extension of time.

Please charge to Deposit Account 08-2025 the sum of \$ 500. At any time during the pendency of this application, please charge any fees required or credit any over payment to Deposit Account 08-2025 pursuant to 37 CFR 1.25. Additionally please charge any fees to Deposit Account 08-2025 under 37 CFR 1.16 through 1.21 inclusive, and any other sections in Title 37 of the Code of Federal Regulations that may regulate fees. A duplicate copy of this sheet is enclosed.

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Signature: Christie A. Doolittle

Respectfully submitted,

Patricia S. Kruse

By Walter W. Karnstein

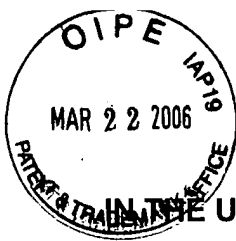
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of

Dated: March 20, 2006

PATRICIA S. KRUSE

HP Docket No. 10010789-1

Serial No. : 09/929,430

Examiner M. Milia

Filed : August 13, 2001

Group Art Unit 2622

For : PRESENTATION PRINT JOB PROFILING

Mail Stop Appeal Brief-Patents
Commissioner for Patents
P. O. Box 1450
Alexandria, Virginia 22313-1450

Sir:

BRIEF OF APPELLANT

This Brief is presented in opposition to the Examiner's rejection of claims 1-32 in the Office action dated September 20, 2005.

I. REAL PARTY IN INTEREST

The real party in interest is Hewlett-Packard Development Company, LP, a limited partnership established under the laws of the State of Texas and having a principal place of business at 20555 S.H. 249 Houston, TX 77070, U.S.A. (hereinafter "HPDC"). HPDC is a Texas limited partnership and is a wholly-owned affiliate of Hewlett-Packard Company, a Delaware Corporation, headquartered in Palo Alto, CA. The general or managing partner of HPDC is HPQ Holdings, LLC.

II. RELATED APPEALS AND INTERFERENCES

There are no known related appeals or interferences.

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KH Docket No. HPCB 367

III. STATUS OF CLAIMS

The present application was filed on August 13, 2001 with original claims 1-32. In the response dated June 23, 2005, responsive to the Office action dated March 23, 2005, appellant amended claims 1, 3-6, 9, 11-14, 17, 19-22, 25 and 27-30. In the response dated November 21, 2005, responsive to the Final Office action dated September 20, 2005, appellant made no amendments to the claims.

Claims 1-32, as amended in the response dated June 23, 2005, are the claims at issue in this appeal.

IV. STATUS OF AMENDMENTS

No amendments have been made subsequent to appellant's response dated June 23, 2005.

V. SUMMARY OF CLAIMED SUBJECT MATTER

The summary is set forth in exemplary embodiments. Discussions about elements and recitations of claimed subject matter can be found at least at the cited locations in the specifications and drawings.

The claims of the present application are directed to methods of printing a plurality of files in a presentation package, and computer-readable mediums, computing devices and user interfaces for printing a plurality of files in a presentation package.

Claim 1 is an independent claim directed to a method of printing a presentation package in response to a single print request. With reference to Fig. 9, the method comprises adding 904 a plurality of files to a presentation profile. The method further comprises, with respect to each of the files in the presentation profile, specifying 906, 914 individual printing characteristics and specifying 908, 910, 912 individual packaging

characteristics. In addition, the method comprises printing in response to a single print request 916 a presentation package, which includes each file in the presentation profile, based on the individual printing and packaging characteristics corresponding to each file in the presentation profile.

Claim 9 is an independent claim directed to a computer-readable medium comprising computer-executable instructions to print a plurality of files in a presentation. The computer-executable instructions comprise instructions for adding 904 a plurality of files to a presentation profile. The instructions further comprise, with respect to each of the files in the presentation profile, specifying 906, 914 individual printing characteristics and specifying 908, 910, 912 individual packaging characteristics. In addition, the instructions comprise printing in response to a single print request 916 a presentation package, which includes each file in the presentation profile, based on the individual printing and packaging characteristics corresponding to each file in the presentation profile.

Claim 17 is an independent claim directed to a computing device 802 comprising a memory 814, which comprises computer executable instructions 818 for automatically printing each file in a presentation profile. The computing device 802 further comprises a processor 812 operatively coupled to memory 814 and configured to fetch and execute computer executable instructions 818 from memory 814. Computer executable instructions 818 comprise instructions for adding 904 a plurality of files to a presentation profile. The instructions further comprise, with respect to each of the files in the presentation profile, specifying 906, 914 individual printing characteristics and

specifying 908, 910, 912 individual packaging characteristics. In addition, the instructions comprise printing in response to a single print request 916 a presentation package, which includes each file in the presentation profile, based on the individual printing and packaging characteristics corresponding to each file in the presentation profile.

Claim 25 is an independent claim directed to a user interface 106 (depicted in Figs 1-7). User interface 106 comprises a first area 400 for adding a plurality of files to a presentation profile; a second area 602 for specifying a set of individual packaging characteristics with respect to each individual file in the presentation profile; a third area 610 for indicating a set of individual printing characteristics with respect to each individual file in the presentation profile; and a fourth area 204-6 for printing in response to a single print request a presentation package, which includes each file in the presentation profile, based on the individual printing and packaging characteristics corresponding to each file in the presentation profile.

VI. GROUND OF REJECTION

In the Final Office action, claims 1, 4, 6-9, 12, 14, 15-17, 20, 22-25, 28, and 30-32 were rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,579,087 to Salgado ("Salgado").

Further, claims 2, 10, 18, and 26 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Salgado in view of U.S. Patent No. 6,026,416 to Kanerva et al. ("Kanerva et al.").

Moreover, claims 3, 5 11, 13, 19, 21, 27, and 29 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Salgado in view of U.S. Patent No. 5,481,353 to Hicks et al. ("Hicks et al.").

VII. ARGUMENT

The Examiner has improperly rejected Applicant's claims under 35 U.S.C. § 102(b) and under 35 U.S.C. § 103(a). When the claims are reviewed under the current standards for anticipation and obviousness as set by the Federal Circuit Court of Appeals and the Board of Patent Appeals and Interferences, the impropriety of the rejections becomes clear.

i. Standard of Review

Anticipation

Under 35 U.S.C. § 102(b), an invention is anticipated, and thus unpatentable, if the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of the application for patent in the United States. "Rejection [of a claim] for anticipation or lack of novelty requires, as the first step in the inquiry, that all the elements of the claimed invention be described in a single reference. Further, the reference must describe the Appellants' claimed invention sufficiently to have placed a person of ordinary skill in the field of the invention in possession of it." *In re Spada*, 911 F.2d 705, 708, 15 USPQ2d 1655 (Fed. Cir. 1990) (citations omitted).

Obviousness

Obviousness is a question of law based on (1) the scope and content of the prior art; (2) the differences between the prior art and the claims at issue; (3) the level of ordinary skill in the art; and (4) objective evidence of nonobviousness. *Graham v. John Deere Co.*, 383 U.S. 1, 17, 148 USPQ 459, 467 (1966). "In proceedings before the Patent and Trademark Office, the Examiner bears the burden of establishing a *prima facie* case of obviousness based upon the prior art." *In re Fritch*, 972 F.2d 1260, 1265, 23 USPQ2d 1780, 1783 (Fed. Cir. 1992). "If examination at the initial stage does not produce a *prima facie* case of unpatentability, then without more the applicant is entitled to grant of the patent." *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992).

"To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. M.P.E.P. (citing *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Teachings in a reference indicating that a proposed combination should not be made must be considered when determining whether there is a motivation to make the proposed combination. *In re Young*, 927 F.2d 588, 18 USPQ2d 1089 (Fed. Cir. 1991). For example, the proposed modification can not render the prior art unsatisfactory for its intended purpose. *In re Gordon*, 733 F.2d 900 (Fed. Cir. 1984). Moreover, the proposed modification can not change the principle of operation of a reference. *In re Ratti*, 270 F.2d 810 (CCPA 1959).

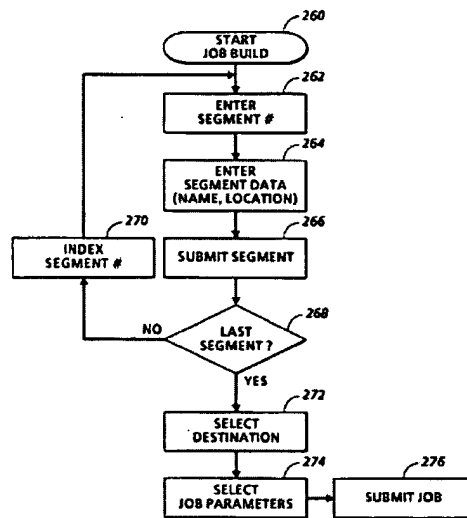
The law is “clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references.” *In re Dembiczak*, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999) (citations omitted).

ii. Discussion

Appellant asserts that A) the rejection of claims 1, 4, 6-9, 12, 14, 15-17, 20, 22-25, 28, and 30-32 under 35 U.S.C. § 102(b) as being anticipated by Salgado is improper; B) the rejection of claims 2, 10, 18, and 26 under 35 U.S.C. § 103(a) as being unpatentable over Salgado in view of Kanerva et al. is improper; and C) the rejection of claims 3, 5 11, 13, 19, 21, 27, and 29 under 35 U.S.C. § 103(a) as being unpatentable over Salgado in view of Hicks et al. is improper.

A. Salgado Fails to Disclose Each Feature Recited in the Claims

The Examiner has failed to show that Salgado discloses each feature recited in claims 1, 4, 6-9, 12, 14, 15-17, 20, 22-25, 28, and 30-32, thus making the rejection of these claims under 35 U.S.C. § 102(b) improper.



Salgado Fig. 7

Salgado discloses a technique for constructing a print job from multiple segments using a network interface. As shown in the flow diagram above, the technique first involves creating a print job and then specifying parameters for that print job. Creating a complete print job involves initiating a print job editing program, indicating that a segment will be added to the print job by adding a new segment number to the print job, inputting the name and location of the segment to be included in the print job for the indicated segment number, saving the segment as part of the print job, and repeating that process until all segments have been added. Once all the segments have been added to the print job, parameters for a single, master print job are specified. The method of specifying print job parameters includes the steps of selecting a printer to print the print job, selecting paper size, number of print job copies, and whether the print

job will be collated and stapled. After the print job parameters are specified, printing of the print job is initiated by submitting the print job.

FIG. 5 is a menu interface for adding segments to a print job. It features a 'JOB NAME' field with the value 'XXX' (labeled 202) and a 'SEGMENT #' field (labeled 224). There are two buttons: 'SAVE SEGMENT' (labeled 226) and 'ENTER JOB DATA' (labeled 228). The 'SEGMENT SOURCES' section (labeled 206) includes options for 'REMOTE SOURCE 1' (207), 'REMOTE SOURCE 2' (208), 'FLOPPY' (210), 'LOCAL' (212), and 'DISC' (214). The 'ENTER FILE I.D.' section (labeled 216) contains a keypad with numbers 1-9, 0, and symbols, along with letters A-Z. The 'PRINT DESTINATION' section (labeled 218) includes options for 'PRINTER 1' (218), 'PRINTER 2' (218), 'FAX 1' (220), and 'FAX 2' (220). A 'SELECT DESTINATION' button (labeled 221) is also present.

FIG. 5

FIG. 6 is a menu interface for specifying print job parameters. It features a 'JOB NAME' field with the value 'XXX' (labeled 202). The 'COPY FEATURES' section (labeled 230) includes options for 'PAPER SIZE 8.5 x 11' (230) and 'COLLATED/STAPLED' (232). The 'FILESERVER' section (labeled 236) includes options for 'XXX' (236) and 'SAVE AS...' (236). The 'QUANTITY' section (labeled 234) includes a keypad with numbers 1-9, 0, and symbols. The 'FAX NUMBER' section (labeled 238) includes a keypad with numbers 1-9, 0, and symbols, along with 'START' and 'CANCEL' buttons.

FIG. 6

As shown in Figs. 5 and 6 above, the steps of inputting segments into a print job and specifying print job parameters take place in two separate menus. In Fig. 5, a user can add segments to Print Job XXX by specifying a segment # in field 224 and entering segment data, such as its location using menu 206, a designated printer using menu 218, and file name using keypad 222. Once the user enters all segment info, he saves the segment to the print job by pressing button 226. When all segments have been saved to the print job, print job parameters are selected with the Fig. 6 menu. The Fig. 6 menu pertains to the print job as a whole (i.e., a single master print job) and not the individual segments in the print job, as indicated by the menu displaying only Print Job XXX in the heading. With the Fig. 6 menu, a user selects print job parameters, such as paper size from menu 230, collating and stapling from menu 234, and the number of copies of the print job to print at field 234.

i. Claims 1, 4, 6-8

Salgado does not disclose each feature recited in independent claim 1, or claims 4 and 6-8, depending from claim 1. Claim 1 is provided in full in the Appendix below, but generally recites a method comprising adding a plurality of files to a presentation profile; specifying individual printing characteristics for each file; specifying individual packaging characteristics for each file, and printing the files in response to a single print request based on the specified individual printing and packaging characteristics.

Printing characteristics are distinct from packaging characteristics. In *Phillips v. AWH Corp.*, 415 F.3d 1303 (Fed. Cir. 2005), the Federal Circuit Court of Appeals declared that claims shall be construed by focusing primarily on how one skilled in the art would interpret the claims in light of the specification, rather than interpreting them in the abstract. *Id.* Applicant's specification describes packaging characteristics as whether the presentation package will be stapled or collated, which subset of files will be included in a general distribution package and which will be included in a different presentation package, and how many copies of the general distribution and presentation package will be printed. In contrast to packaging characteristics, the specification describes printing characteristics as which printer will be used and what media will be used. Thus, printing characteristics and packaging characteristics are properly interpreted as distinct features and as covering subject matter consistent with each of their descriptions in the specification.

Salgado does not disclose a method comprising the step of specifying a set of individual packaging characteristics with respect to each file added to a presentation

profile. As shown in Fig. 6 above, Salgado specifies print job parameters for the entire print job. It does not specify parameters for each individual segment. As interpreted by the Examiner, a segment is analogous to a file, and parameters are analogous to packaging characteristics as recited in claim 1. Viewed through this frame of reference, Salgado discloses specifying packaging characteristics for an entire presentation profile, but not specifying individual packaging characteristics for each file.

Contrary to the Examiner's assertion, Salgado does not disclose specifying individual packaging characteristics for each segment. In fact, the Examiner's proposed "packaging characteristics" would be inconsistent with the description of "packaging characteristics" throughout the specification. If anything, Salgado relates to specifying printing characteristics for each segment. Thus, Salgado does not disclose specifying individual packaging characteristics.

Because Salgado does not disclose specifying a set of individual packaging characteristics with respect to each of the files, it does not disclose each feature of claim 1. Accordingly, Salgado does not anticipate claim 1 under 35 U.S.C. § 102(b). Moreover, because claims 4 and 6-8 depend from claim 1, Salgado does not anticipate these claims either.

With particular regard to claim 4, Salgado does not disclose selecting packaging characteristic options comprising stapling and collating for a subset of files. Indeed, Salgado does not disclose specifying individual packaging characteristics for a subset of files, as discussed above. Rather, Salgado at step 274 selects from menu 232 in Fig. 6

whether the entire print job should be stapled or collated, not whether individual segments are stapled or collated.

ii. Claims 9, 12, and 14-16

Salgado does not disclose each feature recited in independent claim 9, or claims 12 and 14-16 depending from claim 9. Claim 9 is provided in full in the Appendix below, but generally recites a computer-readable medium comprising computer-executable instructions to print a plurality of files in a presentation. The computer executable instructions comprise instructions for adding a plurality of files to a presentation profile; specifying individual printing characteristics for each file; specifying individual packaging characteristics for each file, and printing the files in response to a single print request based on the specified individual printing and packaging characteristics.

As noted above, printing characteristics are distinct from packaging characteristics. Applicant's specification describes packaging characteristics as whether the presentation package will be stapled or collated, which subset of files will be included in a general distribution package and which will be included in a different presentation package, and how many copies of the general distribution and presentation package will be printed. In contrast to packaging characteristics, the specification describes printing characteristics as which printer will be used and what media will be used. Thus, printing characteristics and packaging characteristics are properly interpreted as distinct features and as covering subject matter consistent with each of their descriptions in the specification.

Salgado does not disclose computer-executable instructions comprising instructions for specifying a set of individual packaging characteristics with respect to each file added to a presentation profile. As shown in Fig. 6 above, Salgado specifies print job parameters for the entire print job. As interpreted by the Examiner, a segment is analogous to a file, and parameters are analogous to packaging characteristics as recited in claim 9. Viewed through this frame of reference, Salgado discloses specifying packaging characteristics for an entire presentation profile, but not specifying individual packaging characteristics for each file.

Because Salgado does not disclose specifying a set of individual packaging characteristics with respect to each of the files, it does not disclose each feature of claim 9. Accordingly, Salgado does not anticipate claim 9 under 35 U.S.C. § 102(b). Moreover, because claims 12 and 14-16 depend from claim 9, Salgado does not anticipate these claims either.

With particular regard to claim 9, Salgado does not disclose selecting packaging characteristic options comprising stapling and collating for a subset of files. Indeed, Salgado does not disclose specifying individual packaging characteristics for a subset of files, as discussed above. Rather, Salgado at step 274 selects from menu 232 in Fig. 6 whether the entire print job should be stapled or collated, not whether individual segments are stapled or collated.

iii. Claims 17, 20, and 22-24

Salgado does not disclose each feature recited in independent claim 17, or claims 20 and 22-24 depending from claim 17. Claim 17 is provided in full in the

Appendix below, but generally recites a computing device comprising a memory with computer-executable instructions for automatically printing each file in a presentation profile; and a processor operatively coupled to the memory and configured to fetch and execute the computer-executable instructions from the memory. The computer executable instructions comprise instructions for adding a plurality of files to a presentation profile; specifying individual printing characteristics for each file; specifying individual packaging characteristics for each file, and printing the files in response to a single print request based on the specified individual printing and packaging characteristics.

Applicant again notes that printing characteristics are distinct from packaging characteristics. Applicant's specification describes packaging characteristics as whether the presentation package will be stapled or collated, which subset of files will be included in a general distribution package and which will be included in a different presentation package, and how many copies of the general distribution and presentation package will be printed. In contrast to packaging characteristics, the specification describes printing characteristics as which printer will be used and what media will be used. Thus, printing characteristics and packaging characteristics are properly interpreted as distinct features and as covering subject matter consistent with each of their descriptions in the specification.

Salgado does not disclose computer-executable instructions comprising instructions for specifying a set of individual packaging characteristics with respect to each file added to a presentation profile. As shown in Fig. 6 above, Salgado specifies

print job parameters for the entire print job. It does not specify parameters for each individual segment. Even assuming the Examiner's assertion that a segment is analogous to a file and parameters are analogous to packaging characteristics, Salgado only discloses specifying packaging characteristics for an entire presentation profile. Salgado does not disclose specifying individual packaging characteristics for each file.

Because Salgado does not disclose specifying a set of individual packaging characteristics with respect to each of the files, it does not disclose each feature of claim 17. Accordingly, Salgado does not anticipate claim 17 under 35 U.S.C. § 102(b). Moreover, because claims 20 and 22-24 depend from claim 17, Salgado does not anticipate these claims either.

With particular regard to claim 20, Salgado does not disclose selecting packaging characteristic options comprising stapling and collating for a subset of files. Indeed, Salgado does not disclose specifying individual packaging characteristics for a subset of files, as discussed above. Rather, Salgado at step 274 selects from menu 232 in Fig. 6 whether the entire print job should be stapled or collated, not whether individual segments are stapled or collated.

iv. Claims 25, 28, and 30-32

Salgado does not disclose each feature recited in independent claim 25 or claims 28 and 30-32 depending from claim 25. Claim 25 is provided in full in the Appendix below, but generally recites a user interface comprising a first area for adding a plurality of files to a presentation profile; a second area for specifying individual packaging characteristics for each file; a third area for indicating individual printing characteristics

for each file, and printing the files in response to a single print request based on the specified individual printing and packaging characteristics.

Again, applicant asserts that printing characteristics are distinct from packaging characteristics. Applicant's specification describes packaging characteristics as whether the presentation package will be stapled or collated, which subset of files will be included in a general distribution package and which will be included in a different presentation package, and how many copies of the general distribution and presentation package will be printed. In contrast to packaging characteristics, the specification describes printing characteristics as which printer will be used and what media will be used. Thus, printing characteristics and packaging characteristics are properly interpreted as distinct features and as covering subject matter consistent with each of their descriptions in the specification.

Salgado does not disclose a user interface comprising a second area for specifying a set of individual packaging characteristics with respect to each file added to a presentation profile. As shown in the Fig. 6 user interface above, Salgado provides an area to specify print job parameters for the entire print job. It does not provide an area to specify parameters for each individual segment. Indeed, the Fig. 6 user interface pertains only to Print Job XXX as specific segment fields are not present in the heading along side Print Job XXX field 202. According to the Examiner, a segment is analogous to a file and parameters are analogous to packaging characteristics as recited in claim 25. Viewed through this frame of reference, Salgado shows in Fig. 6 an area for

specifying packaging characteristics for an entire presentation profile, but not an area for specifying individual packaging characteristics for each file.

Because Salgado does not disclose specifying a set of individual packaging characteristics with respect to each of the files, it does not disclose each feature of claim 25. Accordingly, Salgado does not anticipate claim 25 under 35 U.S.C. § 102(b). Moreover, because claims 28 and 30-32 depend from claim 25, Salgado does not anticipate these claims either.

With particular regard to claim 28, Salgado does not disclose selecting packaging characteristic options comprising stapling and collating for a subset of files. Indeed, Salgado does not disclose specifying individual packaging characteristics for a subset of files, as discussed above. Rather, Salgado at step 274 selects from menu 232 in Fig. 6 whether the entire print job should be stapled or collated, not whether individual segments are stapled or collated.

v. Salgado Does Not Anticipate the Claims Rejected by the Examiner

For at least the reasons provided above, Salgado does not disclose each feature recited in claims 1, 4, 6-9, 12, 14, 15-17, 20, 22-25, 28, and 30-32. Accordingly, it does not anticipate the claims under 35 U.S.C. § 102(b). Therefore, the claim rejections under 35 U.S.C. § 102(b) are improper.

B. Combining Salgado with Kanerva et al. Does Not Establish a *Prima Facie* Case that the Rejected Claims are Obvious

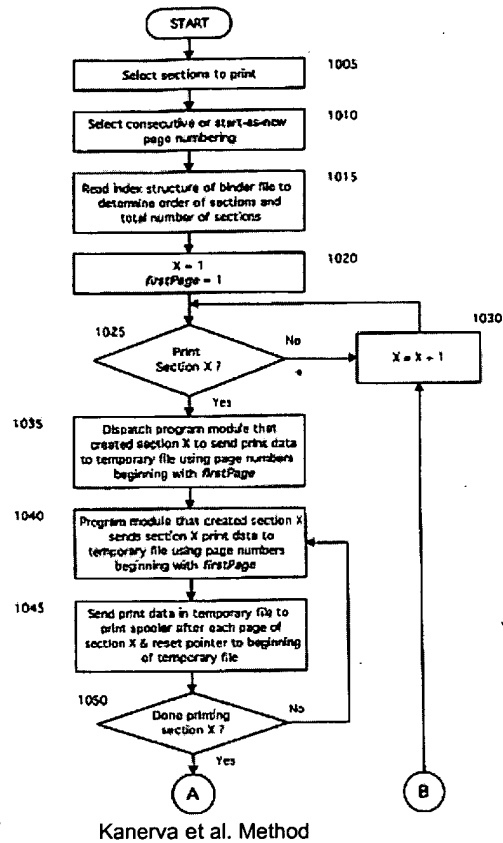
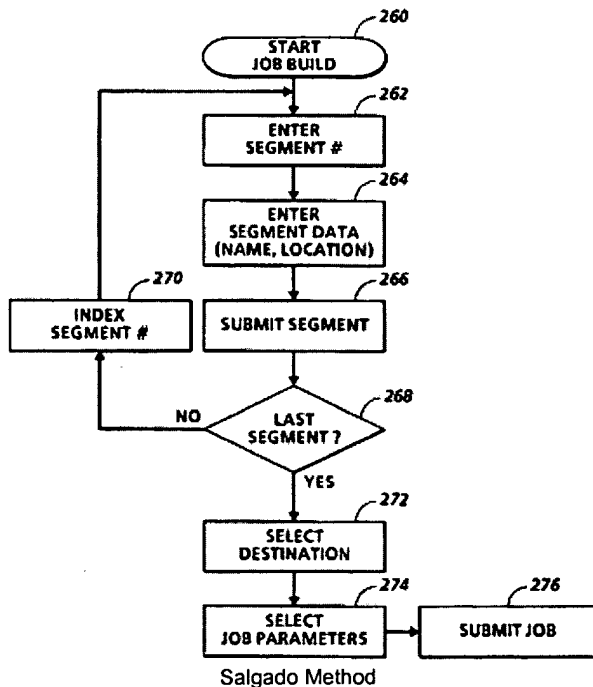
The Examiner has not made a *prime facie* case that claims 2, 10, 18, and 26 are obvious under 35 U.S.C. § 103(a) because one skilled in the art would not be motivated to combine Salgado with Kanerva et al. as proposed by the Examiner. One would not

be motivated to make the combination because Kanerva et al. teaches away from Salgado and because the combination would change the Salgado principle of operation.

The Examiner admits that Salgado does not disclose indicating different subsets of files generated by different computer programs. While the Examiner asserts that Salgado discloses each feature of the underlying independent claims 1, 9, 17, and 25, he relies on Kanerva et al. to disclose indicating different file subsets generated by different computer programs. However, absent a motivation to combine Salgado and Kanerva et al., a rejection based on such a combination under 35 U.S.C. § 103(a) would not be proper.

i. Kanerva et al. Teaches Away from Salgado.

One skilled in the art would not be motivated to combine Salgado with Kanerva et al. because Kanerva et al. teaches away from Salgado. As discussed above, Salgado provides a method for constructing a multi-segment print job from multiple sources using a network interface. Kanerva et al. provides a system and method for processing ordered binder document sections having different file formats.



Kanerva et al. teaches away from specifying printing and packaging characteristics for each file in a presentation profile. The Examiner interprets Salgado as disclosing a method including specifying a set of individual printing characteristics with respect to each file in a presentation profile. In contrast to the central control over printing characteristics described in Salgado, Kanerva et al. states that by "having the corresponding application program control the actual creation of print data rather than the binder program module, better control and quality of the printed section is attained." (Col. 26, ln. 57). Kanerva et al. further highlights that decentralized control "can better control page breaks and other printing parameters that may be customized for [a] particular section." (Col. 26, ln. 60). One seeking to develop the method recited in

claim 1 would not be motivated to combine Salgado, teaching centralized control of printing characteristics, with Kanerva et al., teaching decentralized control.

ii. The Examiner's Proposed Modification of Salgado Changes its Principle of Operation.

One skilled in the art would know that the proposed modification of Salgado with Kanerva et al. would change the Salgado principle of operation. As discussed above, the Examiner interprets Salgado as providing for specifying printing and packaging characteristics for each file in a presentation profile. However, the Kanerva et al. method involves sending commands to application program modules corresponding to each section of the print job to handle printing. Whereas Salgado specifies printing and packaging characteristics at a network interface, Kanerva et al. calls up different application programs to print with application-specific printing characteristics. Thus, combining Kanerva et al. with Salgado would modify Salgado's principle of operation; namely, changing its operating principle from one where printing and packaging characteristics are supplied by a user at a network interface to one where different application programs dictate such characteristics.

iii. There is No Motivation to Combine Salgado and Kanerva et al. and the Claims are Not Prima Facie Obvious.

Because combining Salgado with Kanerva et al. as proposed by the Examiner would modify the Salgado principle of operation, and because Kanerva et al. teaches away from Salgado, one skilled in the art would not be motivated to make the combination. Lacking a motivation to combine the references, the Examiner has failed to meet the burden of establishing a *prima facie* case that claims 2, 10, 18, and 26 are

obvious under 35 U.S.C. § 103(a). Therefore, the rejection of claims 2, 10, 18, and 26 under 35 U.S.C. § 103(a) is improper.

C. Combining Salgado with Hicks et al. Does Not Establish a *Prima Facie* Case that the Rejected Claims are Obvious

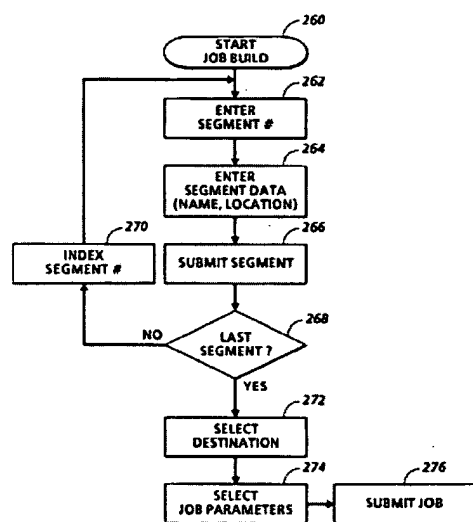
The Examiner has not met his burden of establishing that claims 3, 5 11, 13, 19, 21, 27, and 29 are *prima facie* obvious under 35 U.S.C. § 103(a). The Examiner has not met his burden because combining Salgado and Hicks et al. does not disclose each feature recited in the claims and one skilled in the art would not be motivated to combine the references.

i. Combining Salgado and Hicks et al. does not Disclose Each Feature Recited in the Rejected Claims.

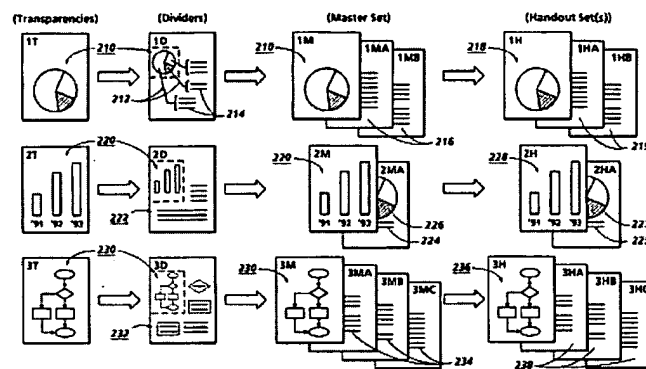
The Examiner asserts that Salgado discloses each feature of independent claims 1, 9, 17, and 25, but that it does not disclose features recited in dependant claims 3, 5 11, 13, 19, 21, 27, and 29. Namely, the Examiner admits that Salgado does not disclose identifying a first subset of presentation package files and a different, second subset of general distribution files as recited in dependant claims 3, 11, 19, and 27. Further, the Examiner admits that Salgado does not disclose indicating the number of copies to print of the first subset of files to be included in the presentation package as recited in dependant claims 5, 13, 21, and 29. Thus, the Examiner relies on Hicks et al. to provide the disclosures missing from Salgado.

Hicks et al. provides an apparatus for producing variable feature presentation sets. The Hicks et al. apparatus is adapted to input an original document, whether in electronic or hardcopy form, and output at least a portion of the original document on

various forms of media. For example, Hicks et al. states that the original document can be printed onto transparencies, divider sheets, master sets, or handout sets. The order of output also can be specified. For example, the divider sheet output can be sequenced such that each transparency is separated by a divider sheet. The source image applied to each type of output media is the same; namely, the original document is applied to each output media type or portions of the original document are applied to each output media type.



Salgado Method



Hicks et al. Method

Salgado combined with Hicks et al. does not disclose the step of identifying a first subset of presentation package files and a different, second subset of general distribution files as recited in dependant claims 3, 11, 19, and 27. The Examiner admits that Salgado does not disclose this feature, but relies on Hicks et al. for its disclosure. However, Hicks et al. does not disclose multiple files and therefore can not disclose indicating a subset of files to be included in a general distribution package.

Instead of disclosing multiple files, Hicks et al. makes repeated references to a single source document. For example, Hicks et al. states that “a hard copy or electronic document is used to generate transparencies, dividers, an/or handouts. . . .” (Col. 9, In 13) (emphasis added). Further, Hicks et al. states that “the master document set may in some embodiments be used as the document upon which the other (edited) documents are based.” (Col. 9, In 15)(emphasis added). The consistent references to a single source document, which is outputted in whole or in part on different types of media, coupled with no references to the use of multiple files indicates that Hicks et al. does not disclose multiple files. Accordingly, Hicks can not disclose indicating a subset of files as recited in the rejected claims.

Salgado combined with Hicks et al. does not disclose the step of indicating the number of copies to print the first subset of files to be included in the presentation package as recited in dependant claims 5, 13, 21, and 29. The Examiner admits that Salgado does not disclose this feature, but relies on Hicks et al. for its disclosure. However, as discussed above, Hicks et al. does not disclose multiple files; thus, Hicks et al. can not disclose indicating how many copies of a subset of files to print. Instead, Hicks et al. discloses printing multiple copies of an original document or multiple copies of a portion of that original document. Because Hicks et al. pertains to an apparatus for printing a single document instead of multiple files, it does not disclose the step of indicating how many copies of a subset of files are to be printed.

ii. No Motivation to Make the Examiner's Proposed Combination

One skilled in the art would not be motivated to combine Salgado with Hicks et al. because such a combination would alter the Salgado principle of operation and would not prove fruitful in solving the problem solved in the rejected claims. The Hicks et al. apparatus operates by inputting a single original document and specifying what type of media, e.g. transparencies or opaque sheets, on which the original document will be printed. The Salgado method, on the other hand, works with multiple files to construct a print job.

Modifying Salgado to input a single original document as taught in Hicks et al., instead of inputting multiple files, would change its principle of operation. Salgado states that an object of its invention is "to provide a technique to initiate selection of multiple remote electronic documents for combination . . . at a printing station for reproduction in a common document." (Col. 2, ln. 36). In contrast, Hicks et al. operates by inputting only a single document. Working with a single document is an entirely different method of printing presentation materials because no combination of files is required. In fact, the ability to combine files into a common print job is a salient feature of Salgado.

One would not be motivated to combine Hicks et al., a single input source reference, with Salgado, a multiple input source reference, to derive the solution of identifying different subsets of files. One desiring to treat different subsets of files in a presentation package differently would not be motivated to look to a reference like Hicks et al. pertaining to only a single file, the original document. To the contrary, to solve this problem a reference pertaining to multiple files is required. The Examiner has admitted that Salgado alone does not disclose identifying different subsets of files. Thus, one must look elsewhere to solve the problem solved by the rejected claims. In fact, one must look to Applicant's application for the first instance that these solutions were disclosed.

iii. Thus, the Examiner's Proposed Combination Does Not Establish that the Rejected Claims are *Prima Facie* Obvious.

Because combining Salgado and Hicks et al. does not disclose each feature recited in claims 3, 5 11, 13, 19, 21, 27, and 29 and because one skilled in the art would not be motivated to make the combination, the Examiner has not met his burden to establish that the rejected claims are *prima facie* obvious. Since a *prima facie* case that the claims are obvious is required to find the claims unpatentable under 35 U.S.C. § 103(a), the rejections are improper.

VIII. CLAIMS APPENDIX

1. A method comprising:
adding a plurality of files to a presentation profile;
specifying a set of individual printing characteristics with respect to each of the files;
specifying a set of individual packaging characteristics with respect to each of the files; and
responsive to a single print request, printing a presentation package including each of the files in the presentation profile based on the individual packaging characteristics and individual printing characteristics corresponding to each of the files.
2. A method as recited in claim 1, wherein a first subset of the files were generated using a first computer program application, and wherein a second subset of the files were generated using a second computer program application that is different than the first computer program application.
3. A method as recited in claim 1, wherein specifying the packaging characteristics further comprises:
identifying a first subset of the files that are to be included in the presentation package and a second subset of the files that are to be included in a general distribution package, wherein the second subset of files is different than the first subset of files.

4. A method as recited in claim 1, wherein specifying the packaging characteristics further comprises:

selecting one or more options to identify how at least one subset of the files of the presentation package are packaged, the one or more options comprising stapling the at least one subset of files together and collating the at least one subset of files.

5. A method as recited in claim 1, wherein specifying the packaging characteristics further comprises:

identifying a subset of files that are to be included in a general distribution package; and

indicating a number of copies to print with respect to the subset of the files that are to be included in the general distribution package.

6. A method as recited in claim 1, wherein specifying the packaging characteristics further comprises:

indicating a number of copies to print with respect to a subset of the files that are to be included in the presentation package.

7. A method as recited in claim 1, wherein specifying the printing characteristics further comprises:

identifying a specific printer to print each of the files.

8. A method as recited in claim 1, wherein specifying the printing characteristics further comprises:

indicating which of a plurality of print media supply bins are to be used by a printer to print individual ones of the files.

9. A computer-readable medium comprising computer-executable instructions to print a plurality of files in a presentation, the computer-executable instructions comprising instructions for:

adding a plurality of files to a presentation profile;

specifying a set of individual printing characteristics with respect to each of the files;

specifying a set of individual packaging characteristics with respect to each of the files; and

responsive to a single print request, printing a presentation package including each of the files in the presentation profile based on the individual packaging characteristics and individual printing characteristics corresponding to each of the files.

10. A computer-readable medium as recited in claim 9, wherein a first subset of the files were generated using a first computer program application, and wherein a second subset of the files were generated using a second computer program application that is different than the first computer program application.

11. A computer-readable medium as recited in claim 9, wherein the instructions for specifying the packaging characteristics further comprising instructions for:

identifying a first subset of the files that are to be included in the presentation package and a second subset of the files that are to be included in a general distribution package, wherein the second subset of files is different than the first subset of files.

12. A computer-readable medium as recited in claim 9, wherein the instructions for specifying the packaging characteristics further comprising instructions for:

selecting one or more options to identify how at least one subset of the files of the presentation package are packaged, the one or more options comprising stapling the at least one subset of files together and collating the at least one subset of files.

13. A computer-readable medium as recited in claim 9, wherein the instructions for specifying the packaging characteristics further comprising instructions for:

identifying a subset of files that are to be included in a general distribution package; and

indicating a number of copies to print with respect to the subset of the files that are to be included in the general distribution package.

14. A computer-readable medium as recited in claim 9, wherein the instructions for specifying the packaging characteristics further comprising instructions for:

indicating a number of copies to print with respect to at least a first subset of the files that are independent of at least a second subset of the files that are to be included in the presentation package.

15. A computer-readable medium as recited in claim 9, wherein the instructions for specifying the printing characteristics further comprising instructions for:

identifying a specific printer to print each of the files.

16. A computer-readable medium as recited in claim 9, wherein the instructions for specifying the printing characteristics further comprising instructions for:

indicating which of a plurality of print media supply bins are to be used by a printer to print individual ones of the files.

17. A computing device comprising:

a memory comprising computer-executable instructions for automatically printing each file in a presentation profile;

a processor that is operatively coupled to the memory, the processor being configured to fetch and execute the computer-executable instructions from the memory, the computer-executable instructions comprising instructions for:

adding a plurality of files to a presentation profile;

specifying a set of individual printing characteristics with respect to each of the files;

specifying a set of individual packaging characteristics with respect to each of the files; and

responsive to a single print request, printing a presentation package including each of the files in the presentation profile based on the individual packaging characteristics and individual printing characteristics corresponding to each of the files.

18. A computing device as recited in claim 17, wherein a first subset of the files were generated using a first computer program application, and wherein a second subset of the files were generated using a second computer program application that is different than the first computer program application.

19. A computing device as recited in claim 17, wherein the instructions for specifying the packaging characteristics further comprising instructions for:

identifying a first subset of the files that are to be included in the presentation package and a second subset of the files that are to be included in a general distribution package, wherein the second subset of files is different than the first subset of files.

20. A computing device as recited in claim 17, wherein the instructions for specifying the packaging characteristics further comprising instructions for:

selecting one or more options to identify how at least one subset of the files of the presentation package are packaged, the one or more options comprising stapling the at least one subset of files together and collating the at least one subset of files.

21. A computing device as recited in claim 17, wherein the instructions for specifying the packaging characteristics further comprising instructions for:

identifying a subset of files that are to be included in a general distribution package; and

indicating a number of copies to print with respect to the subset of the files that are to be included in the general distribution package.

22. A computing device as recited in claim 17, wherein the instructions for specifying the packaging characteristics further comprising instructions for:

indicating a number of copies to print with respect to at least a first subset of the files that are independent of at least a second subset of the files that are to be included in the presentation package.

23. A computing device as recited in claim 17, wherein the instructions for specifying the printing characteristics further comprising instructions for:

identifying a specific printer to print each of the files.

24. A computing device as recited in claim 17, wherein the instructions for specifying the printing characteristics further comprising instructions for:

indicating which of a plurality of print media supply bins are to be used by a printer to print individual ones of the files.

25. A user interface comprising:

a first area for adding a plurality of files to a presentation profile;

a second area for specifying a set of individual packaging characteristics with respect to individual each of the files;

a third area for indicating a set of individual printing characteristics with respect to individual each of the files; and

a fourth area for printing a presentation package including each of the files in the presentation profile in response to a single print request, the printing being based on the individual packaging characteristics and individual printing characteristics corresponding to each of the files.

26. A user interface as recited in claim 25, wherein a first subset of the files are generated using a first computer program application, and wherein a second subset of the files are generated using a second computer program application that is different than the first computer program application.

27. A user interface as recited in claim 25, wherein the second area for specifying the packaging characteristics further comprises:

a fifth area for identifying a first subset of the files that are to be included in the presentation package and a second subset of the files that are to be included in a general distribution package, wherein the second subset of files is different than the first subset of files.

28. A user interface as recited in claim 25, wherein the second area for specifying the packaging characteristics further comprises:

a fifth area for selecting one or more options to identify how at least one subset of the files of the presentation package are packaged, the one or more options comprising stapling the at least one subset of files together and collating the at least one subset of files.

29. A user interface as recited in claim 25, wherein the second area for specifying the packaging characteristics further comprises:

a fifth area for identifying a subset of files that are to be included in a general distribution package and indicating a number of copies to print with respect to the subset of the files that are to be included in the general distribution package.

30. A user interface as recited in claim 25, wherein the second area for specifying the packaging characteristics further comprises:

a fifth area for indicating a number of copies to print with respect to at least a first subset of the files that are to be included in the presentation package.

31. A user interface as recited in claim 25, wherein the third area for specifying the printing characteristics further comprises:

a fifth area for identifying a specific printer to print each of the files.

32. A user interface as recited in claim 25, wherein the third area for specifying the printing characteristics further comprises:

a fifth area for indicating which of a plurality of print media supply bins are to be used by a printer to print individual ones of the files.

IX. EVIDENCE APPENDIX

None presented.

X. RELATED PROCEEDINGS APPENDIX

None presented.

Respectfully submitted,

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